

Appl. No. 10/086,912  
Amendment dated October 14, 2003  
Reply to Office Action of July 11, 2003

### **REMARKS**

Applicants have received and reviewed an Office Action dated July 11, 2003. By way of response, Applicants have amended claim 1 and canceled claim 3 without prejudice. No new matter is presented. Claims 1, 2, and 4-29 are pending. Applicants submit that the pending claims are supported by the specification.

Support for the recitation of amounts in claim 1 can be found at least in original claim 3. Support for the recitation in claim 1 of suitable characteristics of the alcohol can be found in the specification as filed at least at page 7, lines 23-25. Support for the recitation in claim 1 of stability of the composition can be found in the specification as filed at least at page 10, lines 26-29.

For the reasons given below, Applicants submit that the amended claims are in condition for allowance and notification to that effect is earnestly solicited.

### **Restriction Requirement**

Applicants confirm their election with traverse of the claims of Group I. Applicants respectfully note that claims 9-21 relate to a method using the composition of the claims of Group I. Further, claims 22-29 relate to a method of making the composition of the claims of Group I. Applicants respectfully submit that, as spelled out in the MPEP at section 806, these claims should be examined together.

### **Information Disclosure Statement**

Applicants note that the Examiner has requested another copy of each of the 149 references that was submitted with the Information Disclosure Statement mailed on May 28, 2002. Applicants respectfully note that they are confident that the references were enclosed with the Information Disclosure Statement.

Applicants' undersigned representative understands that large stacks of references sometimes become separated from the file and are stored in a room with other large stacks of references (an IDS room). Applicants respectfully request that the Examiner check this or any other likely storage places for large stacks of references. If the references do not turn up in a diligent search, Applicants will provide another copy.

Appl. No. 10/086,912  
Amendment dated October 14, 2003  
Reply to Office Action of July 11, 2003

If the Examiner had already checked likely storage locations before requesting a new copy of the references, Applicants appreciate the Examiner's diligence, and will provide another copy when the Examiner repeats his request.

**Rejection of Claims Under § 112, Second Paragraph**

The Examiner rejected claims 1-9 under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the functional language employed in original claim 1 was proper. Nonetheless, solely to expedite prosecution of the present application and not to acquiesce to the reasoning of the rejection, Applicants have amended claim 1 as suggested by the Examiner. Claim 1 now includes recitation from original claim 3.

Accordingly, it is believed that the amended claims fully comply with § 112, second paragraph, and withdrawal of this rejection is respectfully requested.

**Rejection of Claims Under § 103(a)**

The Examiner rejected claims 1-9 under 35 U.S.C. § 103(a) as being obvious over WO 99/67213 to Solvay (the '213 application). Applicants respectfully traverse this rejection.

The '213 application relates to a method of making an ester peroxycarboxylic acid composition. The method includes incubating a di-acid with peroxide and alcohol. The method makes a composition that can include ester peroxycarboxylic acid and residual alcohol. These compositions employ a stabilizer ('213 application at page 6, lines 18-29, each of the Examples, and claim 9). The stabilizers are antioxidants or sequestrants ('213 application at page 6, lines 18-29, and each of the Examples). The stabilizer is required to provide stability, which the compositions of the '213 application otherwise lack.

In contrast, the presently claimed compositions need not employ a stabilizer for stability. The presently claimed compositions employ C<sub>2</sub> or higher alcohol being effective to maintain at least about 30 % of antimicrobial activity of the composition for at least about 3 months. The present compositions do not require added stabilizer. In fact, and none of the original claims of the present application recites a stabilizer. Further, the presently claimed compositions include alcohols with the property being suitable for use in food products, for cleaning or sanitizing food

Appl. No. 10/086,912  
Amendment dated October 14, 2003  
Reply to Office Action of July 11, 2003

processing equipment or materials, for use in a health-care environment, or a combination thereof.

The presently claimed compositions include alcohols with unexpected properties different from any disclosed in the '213 application. Therefore, the '213 application neither teaches nor suggests the presently claimed invention.

Accordingly, based on the foregoing differences, it is submitted that the reference cited in the prior art rejection neither teaches nor suggests the presently claimed compositions, and withdrawal of this rejection is respectfully requested.

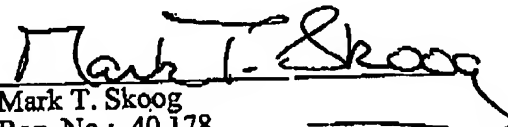
Summary

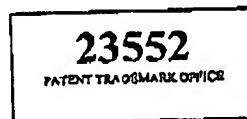
In summary, Applicants submit that each of claims 1, 2, and 4-29 are in condition for allowance. The Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below, if the Examiner believes that doing so will expedite prosecution of this application.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
(612) 332-5300

Date: Oct 14, 2003

  
Mark T. Skoog  
Reg. No.: 40,178  
MTS:sab



RECEIVED  
CENTRAL FAX CENTER

OCT 15 2003

OFFICIAL